

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

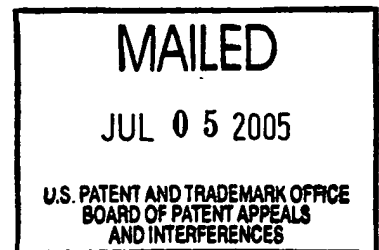
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ELLIOT A. GOTTFURCHT,
GRANT E. GOTTFURCHT
and ALBERT-MICHEL C. LONG

Appeal No. 2005-0926
Application No. 09/518,015

ON BRIEF



Before HAIRSTON, LEVY, and SAADAT, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-10 and 23-48. Claims 11-22 have been withdrawn from consideration (brief, page 4).

BACKGROUND

Appellants' invention relates to an apparatus and method for simple wide-area network navigation. Claim 1 is representative of the invention and is reproduced as follows:

1. A method comprising:

providing a webpage associated with a sister site; and

providing a simplified navigation interface for the webpage by the sister site.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Dolan et al. (Dolan)	5,801,702	Sep. 1, 1988
Arora et al. (Arora)	5,911,145	Jun. 8, 1999
Schein et al. (Schein)	6,388,714	May 14, 2002
		(filed Apr. 11, 1997)
Call	6,418,441	Jul. 9, 2002
		(filed May 21, 1999 or earlier)
Donnelly	6,460,181	Oct. 1, 2002
		(filed Dec. 29, 1998)
Croy et al.	6,476,825	Nov. 5, 2002
		(filed Nov. 12, 1999 or earlier)

Heinemann, "Going from HTML to XML", Microsoft Corporation, pgs. 1-5, Nov. 5, 1998.

Claims 1, 6, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dolan and Arora.

Claims 2, 7, 43, and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dolan and Arora, and further in view of Schein.

Claims 3-5 and 8-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dolan and Arora, and further in view of Heinemann and Call.

Claims 23, 24, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dolan and Arora, and further in view of Croy.

Claims 28-38, 40-42, 47, and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dolan and Arora, and further in view of Donnelly.

Claims 39, 45, and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dolan, Arora and Schein, and further in view of Donnelly.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (mailed September 25, 2003) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (filed July 15, 2003) and reply brief (filed October 27, 2003) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief

have not been considered. See 37 CFR § 41.37(c)(1)(vii)(eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we reverse. We begin with the rejection of claims 1, 6, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Dolan and Arora.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467

(1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, page 3) is that "the creating of links for accessing sites creates a type of access to an associated web page. This is a type of sister site." It is asserted that Dolan teaches serving pages from the sister site responsive to actuation of the link on the web page. When any sister page is selected, web pages are opened, and these web pages are serving pages responsive to the actuation of the link. The examiner acknowledges (answer, pages 3 and 4) that "Dolan fails to teach a specific web page for providing links to sister sites or any other site" but adds that Dolan suggests the need for providing a specific link to a sister site by providing a list of potential sites.

To overcome this deficiency of Dolan, the examiner turns to Arora for a teaching of a web site containing links to various sister sites along with potential outside sites, and that Arora provides a link to a sister site. The examiner adds (id.) that "adding links provides a simplified navigation interface for the web page by the sister site." According to the examiner (answer, page 4) it would have been obvious to an artisan to combine the web site containing links taught by Arora with sister sites responsive to the actuation of links disclosed by Dolan. The examiner's rationale (id.) is that "[d]oing so allows the user

including the user not familiar with computer terminology to navigate to different links within the web site in a timesaving fashion using graphics that are familiar to the layperson."

Appellants' position can be found on pages 11-15 of the brief.

From our review of Dolan and Arora, as well as appellants' disclosure and the arguments of record, we find, for the reasons which follow, that the combined teachings of Dolan and Arora fail to teach all of the limitations of independent claims 1 and 6. We begin with claim construction. Before addressing the examiner's rejections based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, we will initially direct our attention to appellants' claim 1 to derive an understanding of the scope and content thereof.

What we are dealing with in this case is claim construction of the limitations recited in the appealed claims. As stated by the court in In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) "[t]he name of the game is the claim." Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985).

We find that the claim language "providing a web page associated with a sister site" does not permit the web page to be a web page of the sister site. The language "sister site" (underlining added) requires that the sister site is not the same site as the web page. Thus, we find that the claim recites both a web page and a sister site. In addition, from the language "providing a simplified navigation interface for the web page by the sister site" requires that the simplified navigation interface of the web page is provided by the sister site. Thus, the sister site provides the simplified navigation interface for the web site.

Turning to the specification, we find (page 5) that "[a]s used herein, 'sister site' is deemed to mean a site that provides

for navigation of the site using a simplified navigation system" We find from the language in the specification that while a sister site provides simplified navigation, that simplified navigation is not specifically defined, and we consider the language to be quite broad; i.e., simplified compared to what? However, the claim does require that the sister site provides the simplified navigation interface for the web page. This interpretation of claim 1 is consistent with the language of the specification (pages 3 and 6) that figure 2a is an exemplary web page having a sister site link, and that figure 2b is an exemplary first matrix page of a sister site for the web page of figure 2a. Content partners may maintain a database of sister site web pages corresponding to the pages of the general web site, and the content partners may provide a facility for converting web pages on the fly to the sister site format.

Turning to Dolan, we find that the reference is directed to an integrated user interface for accessing a number of network services (col. 1, lines 6 and 7). The reference discusses the difficulties experienced by users in navigating the Internet (col. 2, lines 1-5). The user accesses information by selecting a graphical representation of an item the user wishes to access

from a hierarchal graph (col. 3, lines 14-20). The retrieved information is represented in a hierarchal graph which provides a convenient navigation tool for the user. As an item is retrieved from the network, links contained within the item are parsed from the item and added to the hierarchal graph. The hierarchal graph provides users with a user-interface which is easy to use (col. 3, lines 26-28 and 38-40). Dolan further discloses that icons are used to represent links to HTML documents, whose links are shown in the hierarchal graph (col. 18, lines 17-36). From the disclosure of Dolan, we find that the reference provides a graphical user interface including a hierarchal graph for accessing information obtained from the network, and that the Internet can be accessed.

Turning to Arora, we find that Arora is directed to managing elements of a web site having multiple pages (col. 1, lines 19-21). By using a top-down approach, the user can use a "drag and drop" interface to move icons representing web pages into a hierarchy for the web site (col. 2, lines 16-20). As shown in figure 4, the user has added page icons 452-474 by clicking on New Page button 314 for each new page icon added. Each icon represents a new page added to the site hierarchy. The hierarchy

uses a tree structure, where each branch represents a connection between two pages (col. 6, lines 47-53). Arora further discloses that the system includes connections to the Internet (col. 5, lines 29-34). Figure 43 includes an external link tab for URLs for clip sites. From the disclosure that the system connects to the Internet, and includes external links with URLs to clip sites, we find that the system can access other web sites. However, even if we considered the linked sites of Arora to broadly constitute sister sites, we do not agree with the examiner (answer, page 4) that "adding links provides a simplified navigation interface for the web page by the sister site." Adding links provides simplified navigation to different web sites, but not a simplified navigation interface of a web page associated with the sister site. The claims require that the sister site provides the simplified navigation interface for the web page. The combined teachings of Dolan and Arora, would at most provide that the web page provides simplified navigation to the sister sites, which is not consistent with the language of independent claims 1 and 6, as nothing in the prior art teaches or suggests that the sister site provides the simplified navigation interface for the web page associated with the sister site.

We are in agreement with appellants (brief, pages 12 and 13) that "[t]hus, the navigation graph of Dolan cannot be characterized as a site or a sister site as it is not a site on a network itself, but rather a graphical representation of data in a navigation file. The navigation graph (figure 8C) is not a sister site, but rather is a graphical representation of data."

In Arora, it is disclosed (col. 1, lines 64-66) that "[w]hen the user clicks on a link of the displayed homepage, the browser requests and displays the linked-to-page." From this disclosure of Arora, we find that it was known to click on a link of a displayed home page to have the browser request and display the linked-to page. Taking this disclosure of Arora, with Arora's disclosure (col. 1, lines 37-40) of using a browser to view a web page, we find that Arora suggests links to other web pages. However, we agree with appellants (brief, pages 13 and 14) that having links to other web pages does not simplify the navigation of a web page, and that "this simplified navigation, as characterized by the Examiner, is not provided by a sister site but is provided in the webpage [sic] itself."

From all of the above, we find that the examiner has focussed on the concept of navigating from a web page to other sites which are linked to the web page, but has failed to fully

appreciate the requirement of the claims that the sister site provides the simplified navigation interface for the web page, which is not taught or suggested by Dolan and Arora. We therefore find that the examiner has failed to establish a prima facie case of obviousness of independent claims 1 and 6. Accordingly, the rejection of claims 1, 6, and 25 under 35 U.S.C. § 103(a) is reversed.

The remaining references to Donnelly, Schein, Call, Croy and Heinemann, have additionally been applied by the examiner to meet the dependent claims. Because these references do not make up for the deficiencies of the basic combination of Dolan and Arora, the rejection of claims 2-5, 6-10, and 23-48 under 35 U.S.C. § 103(a) is reversed.

The decision of the examiner to reject claims 1-10 and 23-48 under 35 U.S.C. § 103(a) is reversed.


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